



06 SEP 2007

JACQUELINE E. HARTT, PH.D
ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST, P.A.
P.O. BOX 3791
ORLANDO FL 32802-3791

In re Application of LONG et al. :
Application No.: 10/595,443 : DECISION ON
PCT No.: PCT/AU04/01451 :
Int. Filing: 22 October 2004 : RENEWED PETITION
Priority Date: 22 October 2003 :
Attorney Docket No.: 0090243 : UNDER 37 CFR 1.47(a)
For: QUALITATIVE DATA ANALYSIS :
SYSTEM AND METHOD :

This is a decision on applicant's renewed petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 12 July 2007, to accept the application without the signatures of joint inventors, Linda Godfrey and Kerry Leigh Hicks. Petitioner requests a two month extension of time, which is granted.

BACKGROUND

On 20 April 2006, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 12 October 2006, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) was required.

On 12 December 2006, applicant filed a petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) requested acceptance of the application without the signatures of inventors Linda Godfrey and Kerry Leigh Hicks, alleging that Ms Godfrey and Ms. Hicks are unavailable to sign the application.

On 26 March 2007, a decision dismissing the petition was mailed to applicant, indicating that petitioner had not demonstrated a diligent effort was made to contact the nonsigning inventors and had not provided the nonsigning inventors' last known address.

On 12 July 2007, Petitioner filed the renewed petition.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Petitioner had previously satisfied Items (1) and (4) above.

With respect to Item (2) above, Petitioner provided a copy of the declaration of Martin Gerard Earley previously submitted on 12 December 2006. This declaration was accompanied by a copy of the letter sent to the nonsigning inventor by Joyce Chang, Finance Manager, QSR International Pty Ltd. The letter requests that the nonsigning inventors Hicks and Godfrey contact the patent attorney Martin Early. No further evidence was presented in support of the petition under 37 CFR 1.47(a).

As previously stated in the 26 March 2007 decision, MPEP Section 409.03(d) indicates that where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

The issuance of a single letter does not demonstrate that "diligent efforts" were undertaken to locate the nonsigning inventors to obtain their signatures on the declaration. No further efforts to locate the nonsigning inventors were attempted. No detailed statement of first hand knowledge was presented. A statement by the person with first hand knowledge, which fully describes the exact facts relied on to establish that a diligent effort was made, is required. The diligent efforts to locate the nonsigning inventors were not pursued and documented such as Internet searches, contact with the joint inventors to obtain the nonsigning inventors' current address, current email address and/or current employer. No attempt to reach the nonsigning inventors by telephone was made. No request from the Postal Service for their forwarding address was made.

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the

exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) does not indicate that any search for the nonsigning inventors' new address was made. Since no attempts to locate the inventors were documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventors.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventors. Under these circumstances, it cannot be concluded that then nonsigning inventors are unavailable to sign the application.

Item (3) is still not satisfied because the last known addresses of non-signing inventors were not provided.

In sum, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/595,443 (specification, including claims, drawings, and declaration) to the nonsigning inventors for their signature and their refusal to sign these documents and (2) that "a diligent effort" was made to contact or locate the nonsigning inventors. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

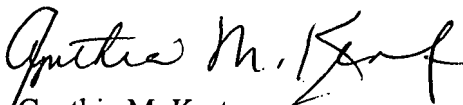
For the reasons set forth above, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Application No.: 10/595,443

4

Office of PCT Legal Administration

Telephone: (571) 272-3286

Facsimile (571) 272-0459